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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/091,333	03/06/2002	Paz Einat	EINAT1.1D	1554
1444 7590 04/25/2007 BROWDY AND NEIMARK, P.L.L.C. 624 NINTH STREET, NW SUITE 300 WASHINGTON, DC 20001-5303			EXAMINER WHITEMAN, BRIAN A	
			ART UNIT 1635	PAPER NUMBER
			MAIL DATE 04/25/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

<b>Advisory Action</b> <b>Before the Filing of an Appeal Brief</b>	Application No.	Applicant(s)	
	10/091,333	EINAT ET AL.	
	Examiner	Art Unit	
	Brian Whiteman	1635	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 16 April 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

#### AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: None.  
Claim(s) objected to: None.  
Claim(s) rejected: 17, 20, 21 and 40.  
Claim(s) withdrawn from consideration: None.

#### AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

#### REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_  
13. ☐ Other: \_\_\_\_\_

*Brian Whiteman*

Continuation of 11. does NOT place the application in condition for allowance because: In response to applicant's statement that the applicant is unaware of no procedure in which the filing date of a new oath or declaration can change the filing date of an application without filing a CIP, the amendment filed on 9/8/06 after the filing of the instant application appears to contain new matter. See MPEP 602 (V) and 603.

In response to applicant's argument that MPEP 2143.03 recites that all limitations of the claims must be considered and given weight including limitations which the examiner does not consider to be supported in the specification as originally filed, the argument is not found persuasive because the citation in MPEP 2143.03 is for evaluating obviousness under 103 not for evaluating new matter under 112 first paragraph.

In response to applicant's argument that deleting the reference to "at least 95% homology" in claims 17 and 40 and the cancellation of claims 41, 42, and 43, the argument is not found persuasive because the amendment to the claims does not address the new matter rejection. Thus, the rejection remains for the reasons of record. See office action mailed on 11/14/06.

In response to applicant's argument that antisense technology is well developed and the specification provides great detail about how the skilled artisan selects appropriate antisense molecules, the argument is not found persuasive because the art of record teaches that antisense has to be determined experimentally in practice (see Agrawal, supra; Uhlmann, supra; and Gerwitz, supra). The generic teaching in the specification of antisense technology, the lack of guidance in the specification for making the genus of antisense molecules recited in the instant claims and the art of record teaching that each antisense has to be determined experimentally indicates that the applicant was not in possession of the claimed invention. See *Fujikawa v. Wattanasin*, 93 F.3d 1559, 1571, 39 USPQ2d 1895, 1905 (Fed. Cir. 1996) and *Purdue Pharma L.P. v. Faulding Inc.*, 230 F.3d 1320, 1328, 56 USPQ2d 1481, 1487 (Fed. Cir. 2000).

In response to applicant's argument that the applicant is not trying to "attempting to preempt the future before it arrives" because the mRNA sequence is provided and the claims require the antisense RNA be homologous to or complement of at least seven nucleotides of this nucleotide sequence, the argument is not found persuasive because while it is acknowledged that the skilled artisan could align a complement to the mRNA, the art of record and lack of guidance in the specification indicates the skilled artisan would not know without further experimentation whether the complement has the functional limitation recited in the instant claims. The specification does not disclose the limitations in the instant claims (as stated in the new matter rejection). In addition, the specification does not disclose what antisense also meet the functional limitation recited in the instant claims. See *Purdue Pharma L.P. v. Faulding Inc and Univ. of Rochester v. G.D. Searle & Co.*, 358 F.3d 916, 927, 69 USPQ2d 1886, 1894-95 (Fed. Cir. 2004).

In response to applicant's argument that if SEQ ID NO: 2 and 10 were known in the prior art, the examiner would not hesitate in making a rejection of antisense claims, stating that it would be obvious to make antisense given the known mRNA sequence and polypeptide sequences, the argument is not found persuasive because as stated above, even if the skilled artisan could align a sequence with mRNA, the skilled artisan would need to further experiment with the sequence to determine if the sequence inhibits expression of the desired protein. In addition, the examiner is unaware of the 112 first paragraph section of the MPEP which teaches that applicant proposing that if the examiner might write a 103 rejection based on hypothetical prior art would indicate written description for a claimed invention.